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In re Application of :
KOO, WOO SEOOG :
Application No.: 10/560,142 : DECISION ON PETITION
PCT No.: PCT/KR04/01856 :
Int. Filing Date: 23 July 2004 :
Priority Date: 24 July 2003 :
Attorney Docket No.: 05-434-B :
For: METHOD FOR ESTABLISHING AN
ATM TRAFFIC CHANNEL PATH
BETWEEN A BSC AND A BTS IN AN
EV-DO SYSTEM

This decision is issued in response to applicant's "Renewed Petition under 37 CFR 1.47(b)" filed 17 January 2007. The petition fee has been submitted.

BACKGROUND

On 23 July 2004, applicant filed international application PCT/KR04/01856 which claimed a priority date of 24 July 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 February 2005. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire on 24 January 2006.

On 09 December 2005, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a copy of the international search report.

On 27 April 2006, the United States Designated/Elected Office mailed "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required.

On 02 November 2006, applicant filed a petition under 37 CFR 1.47(b). In a decision dated 17 November 2006, applicant's petition under 37 CFR 1.47(b) was dismissed without prejudice.

On 17 January 2007, applicant filed the present renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Items (1) through (4) and (6) under 37 CFR 1.47(b) have been satisfied.

Concerning Item (5), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. MPEP 409.03(f).

Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO.

The present petition states that the inventor Woo Seog Koo assigned the invention to Hyundai Syscomm, Inc. ("Hyundai") and that Hyundai subsequently assigned the invention to UTStarcomm Korea Limited ("UTStarcomm"). Petitioner has previously demonstrated a transfer of title from Hyundai to UTStarcomm. Furthermore, the renewed petition includes an appropriate legal memorandum from attorney Joo-Young Kim which states that Hyundai would have title to the present invention instead of inventor Koo. Therefore, a chain of title from Woo Seog Koo to UTStarcomm has been sufficiently established.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Woo Seog Koo under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is GRANTED.

The application will be given an international filing date of 23 July 2004 under 35 U.S.C. 363, and a date of 02 November 2006 under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record. A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.



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